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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/685,525      | 10/16/2003  | Franz-Erich Baumann  | 240709US0           | 6006             |

22850 7590 09/26/2005

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|          |
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| EXAMINER |
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WOODWARD, ANA LUCRECIA

|          |              |
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| ART UNIT | PAPER NUMBER |
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1711

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/685,525

Applicant(s)

BAUMANN ET AL.

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on February 18, 2005
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 4-15 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-15 and 20-24 is/are rejected.
- 7) ☒ Claim(s) 18, 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, it is unclear if or how the “flow aid” distinguishes over the generic “auxiliary” component per claim 9.

In claim 11, it is unclear if or how the “glass particles” distinguish over the generic “filler” component per claim 9.

### ***Claim Rejections - 35 USC § 102/103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6, 7, 9, 10, 12 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese 6-248088 (English translation).

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Japanese '088 discloses nylon resin powder coated with titanium dioxide. In an example, 100 parts by weight of nylon 12 having an average of 5 microns, reading on the presently claimed polyamide, and 48 parts by weight of titanium dioxide fine grains, reading on the presently claimed titanium dioxide particles, are mixed via a high shear mixer to form titanium dioxide coated nylon powders.

The example of the reference meets the requirements of the above-rejected claims both in terms of the types of materials added and the preparation process. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

The recitation of claim 1 "laser sintering" has not been given patentable weight because a preambular recitation is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As to claims 9 and 10, the additional ingredients used by the reference, e.g., metal salts, etc., meet the presently claimed generic "auxiliary" component.

5. Claims 1, 4-10, 12, 13 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. 4,689,364 (Mumcu et al).

Mumcu et al discloses a process for preparing pulverulent coating compositions comprising mixing polyamide granulate with 1 to 30% by weight of titanium dioxide in ethanol followed by precipitation thereof. Suitable polyamides include nylon 11 and nylon12, reading

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on the presently claimed polyamide. The rutile modification of titanium dioxide is preferred, as per claim 8.

The disclosure of the reference meets the requirements of the above-rejected claims both in terms of the types of materials added and the preparation process. The onus is shifted to applicants to establish that the product of the present claims is not the same as or obvious from that set forth by the reference.

The recitation of claim 1 "laser sintering" has not been given patentable weight because a preambular recitation is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The introductory phrase of claim 23, "a method of lowering sensitivity to thermal stress" does not serve to patentably distinguish the claimed process from that of Mumcu et al. This language, in effect, simply states the result of admixing the two polymers. While the reference may not show a specific recognition of this result, its discovery by applicants is tantamount only to finding a property of an old composition.

As to claims 9 and 10, the additional ingredients used by the reference, e.g., solvents, etc., meet the presently claimed generic "auxiliary" component.

#### ***Claim Rejections - 35 USC § 103***

6. Claims 8, 14, 15, 20, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese 6-248088 described hereinabove in view of U.S. 6,211,266 (Weber et al).

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It is within the general disclosure of the Japanese '088 reference to employ nylon powders having average sizes ranging from 1-200 microns (page 2 of translation). Accordingly, the median particle size of polyamide set forth in claims 15 and 24 would have been obvious to one having ordinary skill in the art.

As to claims 8 and 20, rutile and anatase are two of the most common crystal forms of titanium dioxide (per Weber et al, column 8, lines 24-27) and, as such, their use in the composition of Japanese 6-248088 would have been prima facie obvious to one having ordinary skill in the art.

As to claim 14, selective laser-sintering of the powdered product appears to be an obvious alternative to the irradiation technique employed by the reference absent a showing or unusual or unexpected results.

With respect to product-by process claim 15, while the claim may recite process limitations, it is the patentability of the product that must be established. The product is unpatentable because the reference discloses an irradiated product which reasonably appears to be the same or only slightly different from the claimed product.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 4,689,364 (Mumcu et al) described hereinabove.

The general disclosure of polyamide granulates of the reference implicitly suggests any particle size is satisfactory. Accordingly, absent evidence of unusual or unexpected results relative to the claimed nylon particle size, no patentability can be seen therein.

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***Response to Amendments***

8. Applicant's amendments filed February 18, 2005 have effectively overcome the previous 35 U.S.C. 102/103 rejections.

***Allowable Subject Matter***

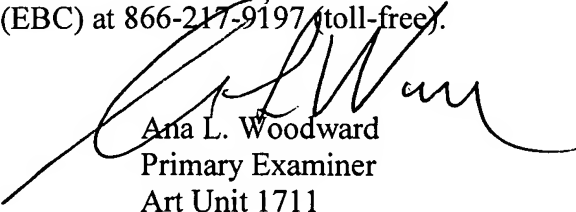
9. Claims 18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ana L. Woodward  
Primary Examiner  
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